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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/577,347	05/24/2000	Maria Ronay	YOR9-2000-0109	5095
7590 09/21/2004			EXAMINER	
Burton A. Amernick Pollock Vande Sande & Amernick RLLP 1990 M Street, N.W. Suite 800 Washington, DC 20036-3425			SONG, MATTHEW J	
			ART UNIT	PAPER NUMBER
			1765	
DATE MAILED: 09/21/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/577,347

Applicant(s)

RONAY, MARIA

Examiner

Matthew J Song

Art Unit

1765

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.  
2. ☐ The proposed amendment(s) will not be entered because:  
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ they raise the issue of new matter (see Note below);  
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see continuation sheet.  
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.  
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 13-36.Claim(s) withdrawn from consideration: 1.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.  
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.  
10. ☐ Other: \_\_\_\_\_

NADINE G. NORTON  
SUPERVISORY PATENT EXAMINER

Art Unit: 1765

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 8/30/2004 have been fully considered but they are not persuasive.

Applicant's argument that Ronay does not disclose that the use of the slurry compositions could or should be used in a polishing process to enhance the polishing rate ratio of silicon dioxide to silicon nitride or the polish rate ratio of metal to silicon dioxide, silicon nitride and/or silicon oxynitride depending upon the type of polyelectrolyte employed. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Ronay teaches using cationic or anionic polyelectrolytes to polish metals or oxides (col 5, ln 20 to col 6, ln 67). Ronay teaches a polishing slurry comprising cationic or anionic polyelectrolytes (claim 1, 5, and 6). A person of ordinary skill using the polishing slurry taught by Ronay on the metal or oxide surfaces taught by applicant's admission would have experienced the increase in polishing rate ratio based on what would have naturally flowed from the prior art.

Applicant's argument that a person of ordinary skill in the art would not be lead by Ronay on how to solve the selectivity problem is noted but is not found persuasive. Applicant's solve the selectivity problem by using either a cationic or anionic polyelectrolytes on a particular surface and using a specific concentration of electrolyte. Ronay teaches using cationic or anionic polyelectrolytes on oxide or metal surfaces to polish the surface. Ronay also teaches a similar concentration of polyelectrolytes, as applicant. Therefore, a person of ordinary skill in the art

Art Unit: 1765

would be able to solve the selectivity problem because Ronay teaches using cationic or anionic polyelectrolyte at a similar concentration to polish a surface.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., employing excess polyelectrolytes) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's argument that Ronay does not suggest selecting the type of polyelectrolyte depending upon the desired polishing selectivity is noted but is not found persuasive. Ronay only teaches using four abrasive particles, alumina, silica, ceria and zirconia and selecting an appropriate polyelectrolyte based on the abrasive particle used. It would have been obvious to a person of ordinary skill in the art at the time of the invention to use the best combination of abrasive and polyelectrolyte to produce a desired result. Because there are only four abrasive, there would be no undue burden to a person of ordinary skill in the art to determine the best abrasive particle for a particular surface. Furthermore, it is well known in the art to use an alumina abrasive, which would require an anionic polyelectrolyte based on Ronay's teaching, on a oxide surface and it is also well known in the art to use a silica abrasive, which would require a cationic polyelectrolyte, on metal surfaces.